

**REMARKS**

Claims 1-10 are all the claims pending in the application.

The description at page 11, lines 17-24, along with the more detailed description in the present Examples, supports amended claim 3.

**I. Rejections Under 35 U.S.C. § 112**

Claims 1, 3-4, 6, and 9 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Claims 3 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly containing a gap between the necessary structural connections.

**Applicants' Response**

Applicants respectfully traverse.

The Examiner's focus during the examination of a claim for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available (*see*, MPEP §2173.02). Some latitude in the manner of expression and aptness of terms should be permitted even though the claim language is not as precise as the Examiner might desire (*see, id.*). The overriding standard to be applied is for the Examiner to give the claim its broadest reasonable interpretation that is consistent with the specification.

In the present case, it is described at page 6, lines 4-14 that when an extruded film layer (a) comprising HDPE is stretched, separations which form voids are formed not only horizontally, *i.e.*, within or parallel to the plane of the film, but also in the vertical dimension, *i.e.*, perpendicular to the plane of the film (Applicants also direct the Examiner's attention to the paragraph bridging pages 6 and 7 of the specification). Applicants respectfully submit that the

meaning of the recitation "porous in a direction perpendicular to the plane of the film" is clear and definite when properly construed according to the teachings of the underlying disclosure.

Furthermore, at page 8, lines 18-28, it is explained that certain embodiments of the present film include at least one non-cavitated layer. Clearly in such embodiments, the film cannot be "porous from one surface to the other in a direction perpendicular to the plane of the film."

However, in other embodiments, the present film does not include a non-cavitated layer. For example, it may be that an easily peelable, non-cavitated backing layer was included during the preparation of the film, *e.g.*, to prevent tearing the film during stretching (*see*, page 8, lines 22-31). After stretching, the non-cavitated backing layer may be separated from the film without much resistance, yielding a final film without a non-cavitated layer. Or, it may simply be that a film of the present invention did not include a non-cavitating layer to begin with. Either way, it is clear that, in these embodiments, a film according to the present invention will be porous from one surface to the other in a direction perpendicular to the film, as stated in the paragraph bridging pages 8 and 9 of the specification.

Turning to claims 3 and 6, the Examiner is correct in her interpretation of "substrate/extruded film layer (a)/coating layer (b)" in claim 3 and "coating layer (b)/extruded layer (a)/core layer (c)/skin layer (d)" in claim 6.

Applicants have amended claim 3 to clarify that the film of claim 1 is laminated on its outer surface opposite the coating layer (b) to a substrate.

As for claim 6, Applicants respectfully submit that the Examiner's correct interpretation is the only reasonable interpretation. In this regard, claim 1 recites that coating layer (b) is coated on extruded film layer (a). Claim 6 further limits claim 1 by reciting that extruded layer (a) is actually coextruded with two other film layers, such that extruded layer (a) and skin layer (d) are on opposite sides of core layer (c). In view of the recitation in claim 1, the only reasonable interpretation is that coating layer (b) is coated on extruded layer (a) so that the

arrangement of the film is "coating layer (b)/extruded layer (a)/core layer (c)/skin layer (d)." Accordingly, claim 6 has not been amended.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw these §112 rejections.

## **II. Rejection Under 35 U.S.C. § 103**

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,087,079 to Newberry, *et al.* ("Newberry") in view of U.S. Patent No. 5,458,590 to Schleinz, *et al.* ("Schleinz").

### **Applicants' Response**

Applicants respectfully traverse.

The prior art references when combined must teach or suggest each and every claim limitation (*see*, MPEP § 2143 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)). In the present case, the combined disclosures of Newberry and Schleinz do not teach or suggest each and every limitation presently recited in the claims. In particular, Newberry and Schleinz at least fail to teach or suggest the presently claimed coating layer (b) coated on a surface of extruded film layer (a), wherein the coating layer is a *porous* ink-receiving layer *with interconnecting voids*.

The present specification describes an advantage of the claimed porous, ink-receiving coating layer (b) that has interconnecting voids. Specifically, layer (b) provides a pathway for an ink to penetrate appreciably into the substrate, thus allowing the substrate to contribute to the dry time (*see*, the paragraph bridging pages 11 and 12 of the specification). Furthermore, the specification describes how the interconnecting voids in layer (b) may be obtained (*see*, page 12, lines 3-9). Still further, the specification includes data from comparative experimentation demonstrating the superior results achieved by employing a porous, ink-receiving coating layer (b) that has interconnecting voids versus a non-porous coating layer.

The superior combination of drying time and cyan density achieved by films coated with a porous, ink-receiving coating layer (b) that has interconnecting voids is completely unexpected from Newberry and Schleinz.

In fact, Newberry and Schleinz are completely silent about a porous, ink-receiving coating layer that has interconnecting voids.

The Examiner has taken the position that "Newberry further shows an image layer (coating layer) comprising gelatin and polyvinyl alcohol which is coated on the imaging element (column 13, lines 5-26)."

The disclosure at column 13, however, does not at all teach or suggest a porous, ink-receiving coating layer that has interconnecting voids. The materials listed therein for the image layer, *e.g.*, gelatin, polyvinyl alcohol, etc., may overlap with the polymeric binder materials described at page 12, lines 10-19 of the present specification. As explained at page 12, lines 3-9, however, the presently claimed porous, ink-receiving coating layer with interconnecting voids is obtained by dispersing particles in the polymeric binder. Newberry is silent with respect to dispersing particles in a binder material to form the claimed porous, ink-receiving coating layer with interconnecting voids.

The Examiner has further asserted that "Newberry shows that calcium carbonate particles, silica, and alumina are added to the layers of the imaging element (column 5, line 30 to column 6, line 20)."

The disclosure spanning columns 5 and 6 of Newberry, however, does not at all relate to Newberry's image layer coating. Instead, Newberry's entire disclosure on void-initiating materials, such as calcium carbonate, silica and alumina, relates to their inclusion in the core or skin layers of Newberry's composite biaxially oriented sheets (Applicants refer to the entire disclosure beginning at column 4, line 20 through column 6, line 52).

Indeed, Newberry first mentions a coating at column 6, lines 53-63. The disclosure therein does not at all teach or suggest the claimed porous, ink-receiving coating layer with interconnecting voids.

To relate Newberry's disclosure on void-initiating materials, such as calcium carbonate, silica and alumina, in a composite biaxially oriented sheet to Newberry's disclosure on image layer coatings is to rely on disconnected teachings within Newberry in an attempt to arrive at a piecemeal reconstruction of the present invention. On the contrary, the proper test for obviousness is what the teachings of the cited reference(s) *fairly* suggest to one of ordinary skill in the art (*see, In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Given that the disclosures on coatings at column 6, lines 53-63 and column 13, lines 5-26 of Newberry do not at all mention a porous, ink-receiving coating layer with interconnecting voids, Newberry does not teach or suggest the presently claimed coating layer (b) coated on a surface of extruded film layer (a), wherein the coating layer is a porous ink-receiving layer with interconnecting voids.

Schleinz does not cure this deficiency of Newberry.


For at least the foregoing reason, Applicants respectfully request that the Examiner reconsider and withdraw this §103 rejection.

### III. Conclusion

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

  
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**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

3. (Amended) A film according to claim 1 which is laminated on an outer surface of the film opposite said coating layer (b) to a paper or plastic substrate.